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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,434	11/15/1999	ADAM W. FINGERMAN	FINGERMAN1-1-1	2945

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FITCH EVEN TABIN & FLANNERY  
120 NORTH LASALLE STREET  
CHICAGO, IL 606033406

EXAMINER
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BRANCOLINI, JOHN R

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/440,434

Applicant(s)

FINGERMAN ET AL.

Examiner

John R Brancolini

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 19, 20, 22, 23 and 25-33 is/are rejected.
- 7) ☒ Claim(s) 14-18, 21 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-33 are pending in the application.

#### ***Priority***

No claim for priority has been made in this application.

#### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "101,103,105" have been used to designate separate items in Figures 2 and 3. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al. (US Patent Number 6324338), hereinafter referred to as Wood.

In regards to claim 9, Wood discloses a storage allocation method comprising:

- o Receiving a request for media program storage services from a client (the client selects criteria for a show to be recorded which updates the criteria database indicating a desire to record, col 4 lines 8-15);
- o Allocating a predetermined amount of client available storage capacity to the client in response to the request (the storage allocation device checks for sufficient disk space and allocates an amount for recording, col 4 lines 34-36);
- o Receiving a request for storage of an identified media program from the client (the client can directly request a show to be recorded, col 5 lines 42-51);
- o Storing the identified media program and determining an amount of client available storage capacity remaining after the storage of the identified program (the recorded show is stored in memory and the remaining space is determined (col 4 line 51, lines 34-36).

Claims 22-23, 27-29, 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Shteyn (US Patent Number 6611654).

In regards to claim 22, Shteyn discloses a media program storage system comprising:

- o A plurality of storage units for receiving and storing a predetermined plurality of media program signals, said storage units being located in different geographic locations (the selected material is recorded and stored at multiple geographic locations, col 1 line 38-43);

- o A network accessible server for receiving requests for storage of identified media program signals from network connected clients and in response to a request from a client for notifying one of the plurality of storage units to receive and store the identified media program signal (a server receives requests for the media to be recorded from the client, selects a storage system and records and stores the program, col 2 lines 53-59);
- o The storage units comprise apparatus responsive to the notifications from the network accessible server for receiving and storing the identified program and for notifying the requesting client of a network address at which to retrieve the stored media program (the storage system is in communication with the server to confirm necessary actions are performed as well as notifying the location of recording and storing, col 3 lines 11-16).

In regards to claim 23, Shteyn discloses a media program storage system comprising apparatus responsive to a delivery request from the client via the network for delivering the stored media program to the client via the network (the storage device streams the recorded content over a data network, col 2 lines 62-64).

In regards to claim 27, Shteyn discloses a media program storage system comprising:

- o Receiving apparatus for receiving media program signals from a plurality of geographic areas (col 3 lines 1-5);

- o A client server for receiving from a client via a computer network a request for storage of an identified one of the media program signals and for directing the connection of the identified media program signal from the receiving apparatus to a storage apparatus, the storage apparatus comprising storage media responsive to the client server for storing the identified media program (a server receives requests for the media to be recorded from the client, selects a storage system and records and stores the program, col 2 lines 53-59).

In regards to claim 28, Shteyn discloses the computer network is the Internet (col 2 lines 63-64).

In regards to claim 29, Shteyn discloses the storage media comprises apparatus responsive to a request received from the client via the computer network for transmitting the stored media program to the client via the computer network (the program to be recorded is selected over the internet, and delivered once recorded through the internet to the desired location for viewing, col 4 lines 19-29, and the show is streamed through the internet after being recorded, col 2 lines 62-64).

In regards to claim 31, Shteyn discloses a method of media program storage comprising:

- o Receiving a plurality of media program signals from a plurality of geographically separated locations (col 3 lines 1-5);

- o Receiving a request for storage of a specified one of the media program signals (a user selects one program to be recorded, col 1 lines 38-39);
- o Connecting the specified media program signal to a media storage apparatus (the server selects a storage device to record the selected program, or media program signal, col 2 lines 57-59);
- o Storing the specified media program signal by the storage apparatus (the program is recorded and stored, col 2 lines 59-62).

In regards to claim 32, Shteyn discloses a method comprising receiving a request for delivery of the stored media program via a computer network (a client transmits the request for recording to a server, col 2 lines 53-55).

In regards to claim 33, Shteyn discloses a method comprising transmitting the stored media program to the client via the computer network (the storage device transfers the recorded event over the network, col 2 lines 63-65).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-13, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Shteyn.

In regards to claim 1, Wood discloses a method of media program selection using a media program storage system comprising:

- o Assigning a preferred media program listing to a client of the media program storage system (a channel guide is provided to the client, col2 lines 58-62);
- o Presenting to the client, via a computer network, the preferred media program listing (the channel guide can be accessed over the internet, col 2 line 67 – col 3 line 4);
- o Receiving from the client a request for storage including the identity of a media program selected by the client (the client selects a set of criteria for recording a show, such as selecting the title of the media program for storage, col 4 lines 10-14, col 5 lines 42-43);
- o Storing the selected media program for the client in response to the received request (if there is sufficient room on the disk, the show is recorded, col 4 lines 35-36).

Wood however lacks the multiple geographic locations having associated media program listings representing media programs available at the geographic locations. Shteyn discloses a system of time and location driven personalized television which utilizes multiple geographically different locations at which the selected media program can be recorded (col 1 lines 39-43, col 3 lines 1-6). This feature allows for recording of the selected media program at a time that is most convenient to the user.



It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wood to include using multiple geographic locations as taught by Shteyn to allow for the recording of selected media programs at a time that is most convenient to the user.

In regards to claim 2, Wood discloses a method in accordance with claim 1 wherein the media programs have an associated start time and the method comprises determining if the start time has not yet occurred and storing the selected program on a storage unit (when programming becomes available, or the start time occurs, the show selected by a user is recorded and stored, col 4 line 19, col 4 lines 35-36).

Again, as with claim 1, Wood lacks the plurality of geographic locations. Shteyn teaches that one of a plurality of geographic locations can be used for recording to increase the convenience of recording for a user (col 3 lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wood to include using multiple geographic locations as taught by Shteyn to increase the convenience of recording for a user.

In regards to claim 3, Wood discloses presenting the client with an opportunity to receive a media program listing other than the preferred media program listing (a user can receive updates to or different channel guides through the internet, col 2 line 67 – col 3 line 4).

In regards to claim 4, Wood discloses a method of changing the presented media program listing in response to a client request (the user can download a different channel guide using the internet, col 2 line 67 – col 3 line 4).

In regards to claim 5, Woods discloses searching the media listings to identify a media program requested by the client (the criteria selected by the user is compared to the channel guide, col 4 lines 10-13). Woods however lacks the plurality of geographic locations. As seen above, Shteyn teaches using multiple geographic locations to increase convenience for the user by providing more opportunities to record the media program.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wood to include the teaching of Shteyn and to include a plurality of geographic locations to increase convenience for the user by providing more opportunities to record the media program.

In regards to claim 6, Wood discloses a method comprising presenting to the client a media program search capability (The user can select certain criteria to search the channel guide for a specific program, col 3 lines 22-27).

In regards to claim 7, Wood discloses a method comprising receiving media program key words from the client for use by the search capability (the user may include specific keywords into the search criteria, col 4 lines 59-65).

In regard to claim 8, Wood discloses a method comprising presenting to the client one or more media programs identified by the search capability (after comparing the search criteria to the channel guide, several shows may be selected for recording and further input from the user may be needed, col 4 lines 19-30).

In regards to claim 10, Wood does not directly disclose notifying the client of the amount of remaining client available storage. But Wood does show the system calculating the remaining storage left to record another show (col 4 lines 33-35). It would have been obvious to one of ordinary skill in the art of online media recording and storage to notify the user of how much storage is remaining.

In regards to claim 11, Wood does not disclose offering additional storage capacity to the client. Shteyn however shows a system utilizing multiple servers and multiple storage devices to record the programs. It would have been obvious to one of ordinary skill in the art of online media recording and storage to offer the user additional storage space, as provided by the plurality of storage devices, in the system of Wood in view of Shteyn.

In regards to claim 12, Wood does not disclose receiving a request from the client for additional storage capacity. Shteyn however shows a system utilizing multiple servers and multiple storage devices to record the programs as requested by a client. It

would have been obvious to one of ordinary skill in the art of online media recording and storage to allow the user to request additional storage space, as provided by the plurality of storage devices, in the system of Wood in view of Shteyn.

In regards to claim 13, Shteyn discloses delivering the stored media program from storage to the client (the program is streamed to the client, col 2 lines 62-66), but Shteyn does not disclose if the storage is increased after the program is delivered. It would have been obvious to one of ordinary skill in the art of online media recording and storage to increase the allocated storage by an amount substantially equal to the storage used to store the delivered media program.

In regards to claim 19, Shteyn discloses the storage device can be a hard drive with a limited storage capacity and storage will not occur once the amount of client available storage is exceeded (col 3 lines 53-56).

In regards to claim 20, Shteyn discloses a remote storage system utilizing several servers and storage devices to record media programs. Shteyn however lacks disclosing whether additional storage space is offered to the client. It would have been obvious to one of ordinary skill in the art of online media recording and storage to offer additional space to a client once the storage space allocated to the client has been exceeded.

Claims 25-26, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn in view of Wood.

In regards to claim 25, Shteyn teaches the use of a network accessible server for means of communication between the client and the recording device (Fig 1, item 104) but fails to disclose the storage of the media listing on the server. Wood discloses a database storing the preferred listing of media programs for access by the client (col 3 lines 1-4, line 8) accessible to the user over the network as a means of quickly allowing the user to view the media programs available.

It would have been obvious to one of ordinary skill in the art to modify Shteyn to include storing the media program listing on the server as taught by Wood to allow the client to access a listing of the available programs from any location connected through the network to the server.

In regards to claim 26, Wood discloses the network accessible server stores listings of media programs in addition to the preferred listing (a user can receive updates to or different channel guides through the internet, col 2 line 67 – col 3 line 4).

In regards to claim 30, Wood discloses the server stores information identifying the plurality of media program signals (the server stores broadcast channel guides identifying each media program signal, col 3 lines 13-14).

***Allowable Subject Matter***

Claims 14-18, 21, 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R Brancolini whose telephone number is (703) 305-7107. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

JRB

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100